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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/405,504    09/23/99    STAHL

A    WHI9721P3MC2

021005    HM12/0326  
HAMILTON BROOK SMITH AND REYNOLDS, P.C.  
TWO MILITIA DR  
LEXINGTON MA 02421-4799

EXAMINER

WEGERT, S  
ART UNIT

PAPER NUMBER

1647  
DATE MAILED:

03/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/405,504

Applicant(s)

STAHL ET AL.

Examiner

Sandra Wegert

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-81 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 7-9, 13-15, 37-39, 43-45, and 49-51, drawn to a method of detecting a compound, classified in class 435, subclass 7.1+.
- II. Claims 4-6, 10-12, 16-18, 40-42, 46-48, and 52-54, drawn to a method of detecting an inhibitor of a compound, classified in class 435, subclass 7.1+.
- III. Claims 19, 23, 27, 29, 31, 33, 35, 55-57, 59, 67, 69, 71, 73-74, 78, and 80-81, drawn to a method of detecting an inhibitor of fatty acid uptake in transfected cells, classified in class 435, subclass 325+.
- IV. Claims 20, 22, 24, 26, 28, 30, 58, 60, 64, and 66, drawn to an inhibitor of fatty acid uptake, class and subclass dependent on structure.
- V. Claims 21, 25, 29, 32, 34, 36, 61-63, 65, 68, 70, 72, and 79, drawn to a method of detecting an inhibitor of fatty acid uptake in animals, class and subclass dependent on structure of inhibitor.
- VI. Claims 75-76, drawn to a method of detecting an inhibitor of fatty acid uptake in prokaryotic cells, classified in class 435, subclass 5.
- VII. Claim 77, drawn to a method of detecting a compound radioactively, classified in class 435, subclass 35.

The inventions are distinct, each from the other because of the following reasons:

The methods of Invention I, II, III, V, VI, and VII are independent and distinct, each from the other, because the methods are practiced with materially different process steps for

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materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps, and goals.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions II, III, V, and VI are related to Invention IV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fatty acid uptake inhibitor of Invention IV can be used therapeutically.

Inventions IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

### ***Species Election***

This application contains claims directed to the following patentably distinct species of the claimed Inventive Groups I, II, and IV-VII. If applicant selects one of the Inventions I, II, or

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IV-VII above, one species of protein or nucleic acid (a-j) must also be selected to be considered responsive.

- a) SEQ ID NO: 48,
- b) SEQ ID NO: 49,
- c) SEQ ID NO: 52,
- d) SEQ ID NO: 53,
- e) SEQ ID NO: 55,
- f) SEQ ID NO: 56,
- e) SEQ ID NO: 57,
- f) SEQ ID NO: 61,
- g) SEQ ID NO: 63,
- h) SEQ ID NO: 67, or
- i) SEQ ID NO: 78.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 4, 19, 20, 21, 75, and 77 are found to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the grounds that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined as well as an election of the species even though the requirement be traversed (37 CFR 1.143).

### **Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (703) 308-9346. The examiner can normally be reached Monday - Friday from 8:30 AM to 5:00 PM (Eastern Time).

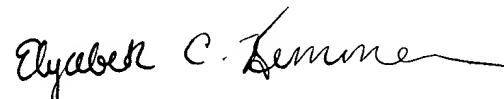
If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

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Official papers filed by fax should be directed to (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SLW

3/23/01

A handwritten signature in cursive script, reading "Elizabeth C. Kemmerer", followed by a long horizontal flourish.

ELIZABETH KEMMERER  
PRIMARY EXAMINER